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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,866	10/30/2003	Puthukode G. Ramachandran	AUS9200030625US1	9754

35525 7590 10/23/2006

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EXAMINER

NEWAY, SAMUEL G

ART UNIT PAPER NUMBER

2193

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,866

Applicant(s)

RAMACHANDRAN ET AL.

Examiner

Samuel G. Neway

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/30/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: on page 12 in the second paragraph, the sentence " The installation tool is configures to enable previously installation application information such as database name ... " contains grammatical errors.

Appropriate correction is required.

Claim Objections

2. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 3 depends on Claim 1, which recites "a set of data processing system". This set has to have at least one data processing system in order for the invention to function as claimed.

3. Claim 6 is objected to because of the following informalities: it is believed the limitation "the knowledge base of prior instructions" should read "the knowledge base of prior installations" and is treated as such for the remainder of the Office Action.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8 – 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 8 – 12:

Claim 8 is directed to a system comprising “detecting means, discovering means, creating means, and sending means”. However, all these means can be reasonably interpreted as being program alone. Program is functional descriptive material and therefore non-statutory, absent being claimed in combination with the necessary hardware to enable the software to act as a computer component and realize its functionality.

Claims 9 – 12 do not add any additional structure to Claim 8 from which they all depend and are therefore rejected for the same reason.

Claims 13 – 17:

Claims 13 – 17 are directed to “a computer program product in a computer readable medium”. According to Applicant’s specification the computer readable medium may include electromagnetic signals. Electromagnetic signals, which are a form of energy, do not fall within a statutory category.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 – 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Fawcett (US Patent 6,327,617).

Claim 1:

Fawcett discloses a method in a data processing system for installing software in a network data processing system (Abstract), by:

detecting an event in the network data processing system, where the event indicates that a software module is to be installed in a set of data processing systems in the network data processing system ("a user computer establishes two-way communications with the update software computer", col. 5, lines 45-51);

discovering a configuration of each data processing system in the set of data processing systems ("an inventory of computer software on the user computer is completed", col. 5, lines 45-51);

creating a set of instructions using a knowledge base of prior installations, where the set of instructions is tailored for each data processing system in the set of data processing systems based on the configuration for the each data processing system in the set of data processing systems ("after the comparison, the user computer is sent back a summary of available computer software", col. 5, lines 51-64);

and sending the set of instructions for the software module to be installed to the set of data processing systems ("the user computer is sent back a summary of available computer software", col. 5, lines 51-64).

Claim 2:

Fawcett discloses the method of claim 1, where the set of instructions includes a future time to request the software module from an installation server ("the user may choose ...to store update information for future update needs ", col. 5, lines 63-64).

Claim 3:

Fawcett discloses the method of claim 1, where the set of data processing systems is at least one data processing system (fig. 2, item 34).

Claim 4:

Fawcett discloses the method of claim 1, where the knowledge base of prior installations is located in an installed product registry ("database connected to the update service computer contain information about computer software which is available to a user", col. 5, lines 51-53).

Claim 5:

Fawcett discloses the method of claim 1, where the set of instructions is executed at a selected time on each data processing system in the set of data processing systems to pull the software module from a source on the network data processing system and install the software module on the set of data processing systems ("re-connect to the user computer at a more convenient time ... and complete the downloading and installation at that time", col. 9, lines 8-12).

Claim 6:

Fawcett discloses the method of claim 1, where the knowledge base of prior instructions includes a mapping between user identities and prior user installation

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configuration data ("comparison is conducted to identify software available ... that might be appropriate for installation", col. 2, lines 52-55).

Claim 7:

Claim 7 is directed to a computer network system (as in fig. 3 in Fawcett) performing the method of Claim 1. Claim 7 is rejected as Claim 1.

Claims 8 – 12:

Claims 8 – 12 are directed to a computer network system performing the method of Claims 1 – 5. Claim 8 – 12 are rejected as Claims 1 – 5.

Claims 13 – 17:

Claims 13 – 17 are directed to a computer program coded to perform the method Claims 1 – 5. Claim 13 – 17 are rejected as Claims 1 – 5.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Neway whose telephone number is 571-270-1058. The examiner can normally be reached on Mon - Thur 8:00AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on 571-272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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